

REMARKS

Applicants acknowledge with appreciation the indication of allowable subject matter. However, for the reasons indicated hereafter it respectfully is urged that all claims (i.e., Claims 18 to 27, 29 to 31, 33 to 38 and 40 to 41) should be found to be in condition for allowance.

A Petition for Extension of Time (one month) with the appropriate government fee is being submitted herewith. Claim 18 is amended to use the preferred spelling of "alkoxy."

Applicants have provided a powder composition comprising an iron or iron based powder and method to form high quality powder metallurgy components of high density in a cost effective manner without the need to use further customary time-consuming and costly processing to increase density, such as warm compaction, double pressing, double sintering, sintering at elevated temperatures, etc. In all embodiments of Applicants' technology there is included "a lubricating amount of an alkylalkoxy or polyetheralkoxy silane wherein the alkyl group of the alkylalkoxy silane and the polyether chain of the polyetheralkoxy silane include between 8 and 30 carbon atoms, and the alkoxy group includes 1-3 carbon atoms."

The continued rejection of Claims 18 to 19, 21 to 23, 29, 30, 33 to 34, 36 to 38 and 40 to 41 under 35 U.S.C. §102(b) as being anticipated by the different teachings of U.S. Patent No. 6,235,076 to Ozaki et al. would be inappropriate.

The different composition of Ozaki et al. is intended to satisfy a different need than that of Applicants. Ozaki et al. seeks to achieve less particle segregation of additives and less generation of dust, and improve flowability and compactability

over a broad temperature range from room temperature to about 200°C.

Accordingly, a different purpose is addressed by Ozaki et al.

See Col. 7, lines 7 to 9 of Ozaki et al. where the following silanes are specified:

- (a) methyltrimethoxysilane,
- (b) phenyltrimethoxysilane, and
- (c) diphenyldimethoxysilane.

Each of these silanes falls outside Applicants' claims. Methyltrimethoxysilane lacks sufficient carbon atoms. See in this regard Example 4 at Pages 8 to 10 of Applicants' Specification. Results with methyltrimethoxysilane were a failure in the context of Applicants' invention. Phenyltrimethoxysilane and diphenyldimethoxysilane each possess a number of carbon atoms that falls within the range of 8 to 30. However, these silanes nevertheless do not meet all aspects of Applicants' claim limitations. It is well recognized that "phenyl" groups and "alkyl" groups are fundamentally different to those skilled in chemistry. They differ in chemical structure and in properties. "Phenyl" specifies a specific structure within the "aryl" designation. "Alkyl" is generic to non-ring chemical structures such as methyl, ethyl, propyl, etc. It respectfully is pointed out that the reasoning expressed at the bottom of Page 2 of the Official Action will not withstand detailed consideration. The concept of Applicants' contribution is lacking in the reasonably derived teachings of Ozaki et al.

It is well established law that patentability is negated under 35 U.S.C. §102 only when the prior disclosure is identical to the invention sought to be patented.

Each and every element of the claimed invention must be disclosed in a single

reference in complete detail. See Akzo N.V. v. United States ITC, 808 F.2d 1471, 1 U.S.P.Q.2d 1241 (Fed. Cir. 1986); Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1 U.S.P.Q.2d 1081 (Fed. Cir. 1986); Rolls-Royce Ltd. v. GTE Valeron Corp., 800 F.2d 1101, 231 U.S.P.Q. 185 (Fed. Cir. 1986); Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 230 U.S.P.Q. 81 (Fed. Cir. 1986); Great Northern Corp. v. Davir Core & Pad Co., 782 F.2d 159, 228 U.S.P.Q. 356 (Fed. Cir. 1986); In re Donohue, 766 F.2d 531, 226 U.S.P.Q. 619 (Fed. Cir. 1985); W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983); SSIH Equip. S.A. v. United States ITC, 713 F.2d 746, 218 U.S.P.Q. 678 (Fed. Cir. 1983); and Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989).

Finally, a continued rejection of Claims 20 and 35 under 35 U.S.C. §103(a) over the different teachings of Ozaki et al likewise would be inappropriate. Basic deficiencies in the Ozaki et al. teachings are discussed above. Also, comparative data present in Applicants' Specification has demonstrated the different results that are achieved when practicing Applicants' teachings. Ozaki et al. used different technology to pursue a different objective. No *prima facie* showing of obviousness has been established or is possible in view of Applicants' teachings and the data present at Pages 8 to 10 of Applicants' Specification.


The withdrawal of the rejections is in order and is respectfully requested.

If there is any remaining point that requires clarification prior to the allowance of the Application, the Examiner is urged to telephone the undersigned attorney so that the matter can be discussed and resolved.

Respectfully submitted,

BUCHANAN INGERSOLL PC

Date: September 8, 2005

By: 
Benton S. Duffett, Jr.
Registration No. 22,030

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620